UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,923	02/17/1998	DAN KIKINIS	P3295	8936

24739 7590 03/17/2004

CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS, CA 95004

EXAMINER	
GEORGE, KEITH M	

ART UNIT	PAPER NUMBER
2663	

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 39

Application Number: 09/024,923
Filing Date: February 17, 1998
Appellant(s): KIKINIS, DAN

Donald R. Boys
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 December 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claim 10 has been amended by supplemental amendment of 1 March 2004 to depend from claim 7.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is substantially correct.

The supplemental amendment after final rejection filed on 1 March 2004 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that all claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,604,737	Iwami et al.	2-1997
6,198,738	Chang et al.	3-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-7, 10-13 and 15-18 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 34 and is repeated here for convenience.

Regarding claims 1, 7, 13 and 18, Iwami et al. discloses a bridge unit and method comprising: a trunk line port for receiving and placing COST telephone calls (i.e. fig. 1, between 20 and 3, inherently there's a port in order to connected the PSTN network to the server); a data network port and circuitry for placing LAN calls (i.e. fig.1, between 20 and 1, inherently there's a port in order to connect the server to the LAN); conversion between LAN and COST telephone calls (i.e. fig.7, 22, fig. 8, col. 11, ll. 5-15); a lookup table (i.e. col. 17, ll. 3-7) relating COST telephone number to IP addresses (i.e. col. 15, ll. 41-54, the terminal may have a telephone number so the communication may be established and connection to take place) wherein control routine function, extract specific data to access the lookup table (i.e. fig. 18, col. 15, ll. 41-55, the extension and/or the terminal address has to be extracted in order to be compared) and enabling 2 people to engage in a live conversation (i.e. fig. 8, col. 11, l. 20 – col. 12, ll. 15). Iwami et al. does not specifically disclose that the LAN network includes the Internet. However, Iwami et al. discloses that the communication terminal could be using TCP/IP or UDP/IP, which are well-known standards used by the Internet (i.e. col. 17, ll. 44-58; voice communication maybe

adopted to support these protocols). While it is clear from Iwami et al. that the LAN used to connect the telephone to the communication terminal could be the Internet, by explicitly stating the LAN can run TCP/IP or UDP/IP and by teaching globally routable Internet address in figure 18, Chang et al. also teaches a method and apparatus for completing calls between a telephone stations attached to a public switched telephone network (PSTN) and a personal computer (PC) attached to a data network (VoIP) where the network connecting the two devices could be the Internet (i.e. fig. 1, 20; col. 1, 13-25). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include the internet and allow the transmitted voice communication to travel through the internet as taught by Chang et al. with the method and system of Iwami et al. in order to communicate with the greatest number of possible users. The motivation is the desire to use the network that is the most broadly available and therefore preferred. It should also be noted the even without a secondary reference, Iwami et al. clearly suggests the use of the Internet by teaching multiple aspects of the LAN that directly apply to the Internet.

Regarding claims 4 and 10, Iwami et al. discloses specific data is coded in an IP address (i.e. fig. 18. the IP address correlates to the telephone number).

Regarding claims 5-6 and 11-12, Iwami et al. discloses negotiating with a caller and using IVR (i.e. fig. 5, the flowchart shoes the usage of a voice communication request server) to obtain the desired address or phone number (i.e. fig. 5, 124, using the received request the communication is selected).

Regarding claim 15, Iwami et al. discloses the first port connected to a PSTN (i.e. fig.1, 3, it is inherent that because the public network is connected to a telephone it is connected to a

PSTN) and the second connected to a LAN (i.e. fig. 1, 1). Iwami et al. does not specifically disclose that the LAN network includes the Internet. However, Chang et al. teaches that the network could be Internet (i.e. fig. 1, 20; col. 1, 13-25). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include the internet and allow the transmitted voice communication to travel through the internet as taught by Chang et al. with the method and system of Iwami et al. in order to communicate with the greatest number of possible users. The motivation is the desire to use the network that is the most broadly available and therefore preferred.

(11) Response to Argument

Background

The conversion of standard telephone numbers assigned to Public Switched Telephone Network (PSTN) telephone devices into Internet Protocol (IP) addresses, e.g. john.doe@uspto.gov, assigned to devices connected to the Internet and vice versa to enable a user of a PSTN telephone device and a user of a Voice over IP (VoIP) telephone device to hold a voice conversation is well-known in the art and has been commercially available for many years. It is a basic requirement necessary to enable a PSTN call or a VoIP call to leave its originating network and terminate on a different network. Without this functionality, PSTN and VoIP would be confined to there own networks and would not be capable of transferring a voice call between the networks, this has been one of the main features of VoIP which has allowed it grow into a serious competitor to the traditional PSTN network.

During the setup and active stages of a PSTN to VoIP or a VoIP to PSTN voice call there are two types of encoding that occur. First, the IP address of the VoIP telephone device is

encoded into the dotted decimal form of john.doe@uspto.gov, e.g. 68.1.10.112, so that it is in a form that may be routed by the network to the appropriate destination device using the TCP/IP protocol. Second, when a connection is established between the PSTN telephone device and the VoIP telephone device, speech encoding occurs to conserve bandwidth on the Internet portion of the call. Encoding conserves bandwidth and allows more data handling capacity on the Internet data network.

Argument

In the first paragraph on page 10 of the Appeal Brief, applicant argues that using the COST (PSTN) or IP address of the incoming call in order to compare it with associated IP address or COST telephone numbers clearly cannot read on extracting specific data encoded into the incoming call either COST or IPNT (VoIP), and using the extracted data to access the look-up table to determine an associated COST number or IP address as claimed. In response, applicant has placed emphasis on the term encoded, however the claim does not provide a definition as to how the data is encoded or how the term differs from the cited prior art. As was shown above, there are two types of encoding which must occur in a PSTN to VoIP or VoIP to PSTN voice conversation. Iwami has been shown to clearly teach that the communication server, upon receiving the voice communication request, responsively transmits a call setting request to the telephone (column 13, lines 33-37). It would not be possible for the communication server to know which telephone to send the call setting request to unless the server decoded information received in the voice communication request to obtain the correct telephone number.

While it is unclear what applicant's argument is in the second paragraph of page 10, applicant admits that Iwami teaches a process wherein an extension number (PSTN telephone number) is entered by a caller, the extension number is encoded and sent to a process which uses a look-up table to determine the IP address (VoIP address) of where to terminate the call. This statement appears to support the argument that Iwami teaches encoding data into an incoming call and using the data to determine an associated terminating telephone.

In the third paragraph of page 10, applicant argues that Iwami nowhere deals with processing an incoming Internet call and deals only with incoming COST (PSTN) calls. In response, the limitations as stated in claim 1 do not require that Iwami teach an incoming Internet call, the limitations with regard to incoming call and associated address are clearly claimed in the alternative, and therefore do not require this limitation. However, it should be noted that Iwami does clearly teach the processing of an incoming Internet call. Figure 11 clearly shows an incoming call from a communication terminal at step 451. It was taught in figure 1 that the communication terminals (10-1 and 10-2) are connected to the LAN, which indicates that figure 11 is teaching an incoming Internet call. Applicant goes on to argue that Iwami does not teach the encoding of data into an IP address associated with an incoming Internet call. In response, Iwami clearly teaches in figure 11, an incoming voice communication request (from a VoIP telephone), the communication server decodes the information contained in that request and sends a call setting request to the appropriate telephone (to a PSTN telephone). Applicant continues to argue that there is simply no manipulation or encoding of any data in the Internet address, as taught in applicant's invention, and positively recited in applicant's claim language. In response, figure 18 clearly shows the relationship between IP addresses and

telephone numbers. The IP address is used to look up the telephone number and therefore the telephone number is encoded into the IP address.

On page 12 of the Appeal Brief, applicant argues that the examination in this case is following the old path of investing prior art status in inventions that accomplish the same or a similar purpose as the invention in examination, rather than following the principle that it is the actual limitations of the claim that must be found in the art. In response, Iwami and Chang have clearly been shown to teach each claim limitation. Specific references to the specification and drawings have been used throughout the rejections to clearly point out which portions of Iwami and Chang are being cited to meet the limitations as stated in the claims.

On page 12, applicant continues to argue that the motivation to extract information from IP addresses to access a lookup table for a COST (PSTN) telephone number, and then making the connection is being derived from applicant's disclosure, not from the prior art. In response, Iwami teaches in reference to figure 18 that it shows the structure of the extension number management table. A column is provided for the extension number and a column for a communication terminal address corresponding to the extension number. The column for the extension number may be used for storing telephone numbers assigned to respective communication terminals (column 15, lines 55-63). Clearly this lookup table is used to determine the IP address of an associated extension number.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Keith M. George
March 5, 2004

Conferees

Chau Nguyen

CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

John Pezzlo

CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS, CA 95004